

1 The opinion in support of the decision being entered today is *not* binding precedent
2 of the Board.

3
4 UNITED STATES PATENT AND TRADEMARK OFFICE

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6
7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES

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11 *Ex parte* BJORN MARKUS JAKOBSSON

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14 Appeal 2007-1751
15 Application 09/769,511
16 Technology Center 3600

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19 Decided: July 26, 2007

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22 Before WILLIAM F. PATE, LINDA E. HORNER, and ANTON W. FETTING,
23 *Administrative Patent Judges.*

24 FETTING, *Administrative Patent Judge.*

25 DECISION ON APPEAL

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27
28 STATEMENT OF CASE

29 Bjorn Markus Jakobsson (Appellant) seeks review under 35 U.S.C. § 134 of a
30 final rejection of claims 2-6 and 8-19, the only claims pending in the application on
31 appeal.

32 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6.

33
34 We AFFIRM.

1 The Appellant invented improved techniques for controlling access of
2 telemarketers or other types of call originators to user terminals of a
3 communication system (Specification 2). An understanding of the invention can
4 be derived from a reading of exemplary claim 16, which is reproduced below
5 [bracketed matter added].

6 16. A method for controlling access of call originators to user
7 terminals in a communication system, the method comprising the
8 steps of:

9 [1] storing for a given user terminal of the system a set of *user-*
10 *specified* access cost information to be applied to one or more
11 incoming calls directed to the user terminal; and

12 [2] determining an amount to charge an originator of a given
13 incoming call directed to the user terminal [3] based at least in part on
14 an access cost for the given incoming call as determined from the
15 user-specified access cost information;

16 [4] wherein the user-specified access cost information is at least in
17 part entered by the user at a web site associated with a service
18 provider that implements the storing and determining steps. (emphasis
19 not in original.)
20

21 This appeal arises from the Examiner's Final Rejection, mailed January 31,
22 2006. The Appellant filed an Appeal Brief in support of the appeal on October 9,
23 2006, and the Examiner mailed an Examiner's Answer to the Appeal Brief on
24 December 8, 2006. A Reply Brief was filed on December 27, 2006.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Haralambopoulos	US 5,148,474	Sep. 15, 1992
Greene	US 5,568,541	Oct. 22, 1996
Chang	US 5,958,016	Sep. 28, 1999
Lynch-Aird	US 6,240,402 B1	May 29, 2001
	(§ 371 filing date Mar. 11, 1998)	
Harrison	US 6,595,424 B1	July 22, 2003
	(provisionally filed Jan. 26, 1996)	

REJECTIONS

Claims 2-5, 8-12, and 15-19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Greene, Lynch-Aird, and Chang.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Greene, Lynch-Aird, Chang, and Harrison.

Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Greene, Lynch-Aird, Chang, Harrison, and Haralambopoulos.

ISSUES

The issues pertinent to this appeal are whether the Appellant has sustained its burden of showing the Examiner erred in rejecting:

- 1 • claims 2-5, 8-12, and 15-19 under 35 U.S.C. § 103(a) as unpatentable over
2 Greene, Lynch-Aird, and Chang;
- 3 • claim 6 under 35 U.S.C. § 103(a) as unpatentable over Greene, Lynch-Aird,
4 Chang, and Harrison; and
- 5 • claims 13 and 14 under 35 U.S.C. § 103(a) as unpatentable over Greene,
6 Lynch-Aird, Chang, Harrison, and Haralambopoulos.

7 These issues turn on whether the prior art teaches or suggests storing user-
8 specified access cost information for a user terminal in a calling system.

9 FACTS PERTINENT TO THE ISSUES

10 The following enumerated Findings of Fact (FF) are supported by a
11 preponderance of the evidence.

12 *Claim Construction*

13 01. The Specification contains no lexicographic definition of “user-
14 specified access cost information.”

15 02. To specify, in the context of setting forth information, is to state
16 explicitly or in detail, or to state as a condition¹.

17 03. Access as a noun is the ability or right to approach, enter, exit,
18 communicate with, or make use of¹.

19 04. The phrase “user-specified” does not constrain the specification by the
20 user to be direct or indirect.

21 05. The phrase “cost information” does not indicate the particular
22 information involved, but only that it pertains to costs in some manner.

1 06. Thus, “user-specified access cost information” is information in some
2 way pertaining to costs that are stated, either directly or indirectly, by the
3 user as a condition for the ability to communicate with a user.

4 *Greene*

5 07. Greene is directed towards adding a surcharge to the cost per call for
6 telephone solicitations and for crediting a portion of the surcharge to the
7 account of the person called (Green, col. 1, ll. 8-11).

8 08. In one embodiment of Greene’s invention, the subscriber’s specified
9 call billing parameters are incorporated into a standard Automatic
10 Message Accounting record which is generated by a carrier switch
11 network for each call. This record is sent to a billing system which
12 processes the charges for inclusion in the network bill sent to the caller
13 and credits a portion of those charges to the account of the person called
14 (Greene, col. 2, ll. 61-67).

15 09. If a call using Greene’s invention is made from a preselected number,
16 i.e., a number which has been approved for direct access to the
17 subscriber, the call is completed in a conventional manner. However, if
18 the number of the calling party is not on the list of pre-approved
19 numbers, the call is identified as a telephone solicitation, and the
20 automated answering system advises the person making the call that a
21 surcharge may or will (at the subscriber’s option) be added to their bill
22 (Green, col. 3, ll. 43-51).

¹ American Heritage Dictionary of the English Language (4th ed. 2000).

1 10. Greene's subscribers enter or program preselected telephone numbers
2 and/or a local exchange into their telephone system (Greene, col. 3,
3 ll. 27-29).

4 11. In Greene's invention, the subscriber has an option to void or waive
5 the surcharge as for example, by pressing one or more keys on his
6 telephone key pad. If, for example, the subscriber is sympathetic to a
7 particular charity or solicitation, he or she may void the surcharge at any
8 time during the conversation by causing the call to bypass the billing and
9 crediting functions (Green, col. 3, l. 65 – col. 4, l. 4).

10 *Lynch-Aird*

11 12. Lynch-Aird is directed towards charge allocation in multi-user
12 networks in which access to the network is not controlled by the network
13 provider (Lynch-Aird, col. 1, ll. 5-8).

14 13. Lynch-Aird provides a communication network with at least two user
15 access points, wherein each user may be allocated a plurality of user
16 identifiers associated with respective predetermined charging schemes.
17 The network is arranged to accept communications including user
18 identifiers in each of a destination identifier field and a source identifier
19 field and a communication monitoring point is arranged to monitor user
20 identifiers in a communication to determine the charging scheme
21 (Lynch-Aird, col. 2, ll. 43-55).

22 *Chang*

23 14. Chang is directed towards providing telephone service customers with
24 a standardized interface for access to service control and management

elements of a communication network, such as the telephone network,
via a public packet switched data network, such as the Internet (Chang,
col. 1, ll. 6-11).

Haralambopoulos

15. Haralambopoulos is directed towards specifying value added
telephone charges (Haralambopoulos, col. 1, ll. 7-15).

16. Haralambopoulos allows the caller to alter the billing by a user action
(Haralambopoulos, col. 5, ll. 1-19).

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given
their broadest reasonable construction consistent with the specification. *In*
re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969);
In re Am. Acad. of Sci. Tech Ctr., 367 F.3d 1359, 1364, 70 USPQ2d 1827,
1834 (Fed. Cir. 2004).

Although a patent applicant is entitled to be his or her own lexicographer of
patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,
347 F.2d 578, 580, 146 USPQ 69, 70 (CCPA 1965). The applicant must do so by
placing such definitions in the Specification with sufficient clarity to provide a
person of ordinary skill in the art with clear and precise notice of the meaning that
is to be construed. *See In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ 2d 1671, 1674
(Fed. Cir. 1994) (although an inventor is free to define the specific terms used to
describe the invention, this must be done with reasonable clarity, deliberateness,

1 and precision; where an inventor chooses to give terms uncommon meanings, the
2 inventor must set out any uncommon definition in some manner within the patent
3 disclosure so as to give one of ordinary skill in the art notice of the change).

4 *Obviousness*

5 A claimed invention is unpatentable if the differences between it and the
6 prior art are “such that the subject matter as a whole would have been obvious at
7 the time the invention was made to a person having ordinary skill in the art.”
8 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d
9 1385 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

10 In *Graham*, the Court held that that the obviousness analysis is bottomed on
11 several basic factual inquiries: “[(1)] the scope and content of the prior art are to be
12 determined; [(2)] differences between the prior art and the claims at issue are to be
13 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383
14 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385
15 (2007).

16 A combination of familiar elements according to known methods is likely to be
17 obvious when it does no more than yield predictable results. *KSR*, at 1731, 82
18 USPQ2d at 1396.

19 For the same reason, “if a technique has been used to improve one device, and
20 a person of ordinary skill in the art would recognize that it would improve similar
21 devices in the same way, using the technique is obvious unless its actual
22 application is beyond that person’s skill.” *Id.*

23 “In determining whether the subject matter of a patent claim is obvious, neither
24 the particular motivation nor the avowed purpose of the patentee controls. What

1 matters is the objective reach of the claim. If the claim extends to what is obvious,
2 it is invalid under § 103.” *Id.* at 1741-42, 82 USPQ2d at 1397.

3 “One of the ways in which a patent’s subject matter can be proved obvious is
4 by noting that there existed at the time of invention a known problem for which
5 there was an obvious solution encompassed by the patent’s claims.” *Id.* at 1742,
6 82 USPQ2d at 1397.

7 ANALYSIS

8 *Claims 2-5, 8-12, and 15-19 rejected under 35 U.S.C. § 103(a) as obvious over*
9 *Greene, Lynch-Aird, and Chang.*

10 *Independent Claim 16*

11 The Appellant argues claims 2-5, 8, 10, 11, and 15-19 as a group.
12 Accordingly, we select claim 16 as representative of the group. Claims 9 and 12
13 are argued separately.

14 The Examiner found that Greene discloses claim element [2], wherein the
15 access cost is charged to the originator and credit at least in part to an account of a
16 called party associated with the user terminal (Answer 3, second to last ¶).
17 However the Examiner further found that Greene does not disclose the remaining
18 limitations of claim 16 (Answer 3, last ¶).

19 To overcome this deficiency, the Examiner found that Lynch-Aird discloses
20 claim element [1], that charging information can be maintained in a suitable
21 charging table; and claim element [3], in which an entry is kept against each
22 allocated recipient identifier indicating the charging scheme associated with the
23 recipient identifier (Answer 4, first ¶).

1 The Examiner also found that Chang discloses claim element [4], a web page
2 which enables subscriber access to control and reporting functionalities of a
3 communication network, such as the advanced intelligent telephone network
4 (Answer 4, second ¶).

5 The Examiner concluded that it would have obvious to one of ordinary skill to
6 modify Greene to include the feature of Lynch-Aird and Chang to provide
7 recipient identifiers to indicate that the corresponding customer received the call
8 and to determine which party pays, as well as, providing the subscriber with online
9 capabilities to modify their service.

10 The Appellant contends that in independent claim 16, it is the user (i.e., the
11 entity receiving the incoming call) in the claimed method that specifies the access
12 cost information rather than the service provider, network operator or other entity
13 (Br. 5, second to last ¶).

14 The Appellant contends that Lynch-Aird does not describe access cost
15 information specified by the user (Br. 7, first ¶). With respect to Greene, Appellant
16 notes that Greene refers to "subscriber's specified call billing parameters" rather
17 than subscriber-specified call billing parameters (emphasis in original). The
18 Appellant further contends that the Examiner explicitly states on p. 2 of the final
19 Office Action that "Greene does not disclose that the user-specified access cost
20 information includes one or more access rules specified by the user and indicates a
21 particular access cost for an incoming call under one or more specified conditions."
22 The Appellant concludes that Greene, like Lynch-Aird, does not teach or suggest
23 "user-specified access cost information" like that claimed in claim 16 (Br. 7 second
24 to last ¶).

1 The Appellant also contends the Examiner failed to show some suggestion or
2 motivation, either in the references themselves or in the knowledge generally
3 available to one of ordinary skill in the art, to modify the reference or to combine
4 reference teachings (Br. 8, second to last ¶).

5 Thus, the issues under contention are whether Greene or Lynch-Aird shows a
6 set of *user-specified* access cost information to be applied to one or more incoming
7 calls directed to the user terminal, and whether it is proper to combine the applied
8 references.

9 The claim element “user-specified access cost information” is construed
10 according to its broadest reasonable interpretation as information in some way
11 pertaining to costs that are stated, either directly or indirectly, by the user as a
12 condition for the ability to communicate with a user (FF 06).

13 Greene describes the subscriber's specified call billing parameters incorporated
14 into a record sent to a billing system which processes the charges for inclusion in
15 the network bill sent to the caller (FF 08).

16 We find that a subscriber's specified call billing parameter is information in
17 some way pertaining to costs that are stated, either directly or indirectly, by the
18 user as a condition for the ability to communicate with a user.

19 Thus, Green shows the claim element of a set of *user-specified* access cost
20 information to be applied to one or more incoming calls directed to the user
21 terminal, and we find the Appellant's arguments unpersuasive.

22

23

1 The remaining issue is whether the applied references are properly
2 combined.

3 We find that Greene is directed towards charging a surcharge to a caller
4 (FF 07), that Lynch-Aird is directed towards applying different charging schemes
5 to calls by using multiple recipient identifiers when multiple networks are
6 involved, (FF 12-13) and Chang is directed toward providing telephone users with
7 an internet interface to manage their accounts (FF 14).

8 We further find that the Examiner's stated motivation to provide recipient
9 identifiers to indicate that the corresponding customer received the call and to
10 determine which party pays, as well as, providing the subscriber with online
11 capabilities to modify their service is supported by these teachings with the art
12 applied.

13 We understand the Examiner's findings as to motivation to be that Greene
14 provides the basic call charging scheme, but its high level teachings raise some
15 implementation detail issues, such as how the system actually traps the identities of
16 the caller and subscriber. Lynch-Aird is directed toward solving this
17 implementation detail by the use of originator and recipient identifiers (FF 12-13).
18 Similarly, Greene does not identify the mechanism that its subscriber would
19 employ to actually provide the information needed to implement the charging
20 scheme. Chang is directed toward solving that implementation detail by providing
21 a standardized interface for managing telephone service through an internet
22 interface (FF 14).

23 As held in *KSR*, a combination of familiar elements according to known
24 methods is likely to be obvious when it yields predictable results. Fleshing out

1 Green with implementation details such as party identifiers and an administrative
2 interface does no more than so identify the parties and allow administration.

3 Similarly, it is the objective reach of the claim that controls, not the patentee's
4 particular motivation, and one of the ways to show obviousness is noting a known
5 problem for which there was an obvious solution encompassed by the claim at
6 issue. *See KSR*. The objective reach of this claim extends no further than Greene,
7 which identified the known problem regarding the need to charge callers, with
8 Lynch-Aird and Chang providing obvious implementation detail solutions.

9 Therefore, it would have been obvious to a person of ordinary skill in the art to
10 have combined Lynch-Aird's and Chang's implementation details to Greene's
11 caller charging scheme to reach the claimed subject matter.

12 Thus, we find that the applied references are properly combined, and we find
13 the Appellant's arguments unpersuasive.

14
15 *Dependent Claim 9*

16 The Appellant separately argues the patentability of claim 9. Claim 9 adds the
17 limitation that the user-specified cost information is stored in a database associated
18 with the user terminal.

19 Appellant's argument is that, the examiner fails to point with any level of
20 specificity where the proposed reference combination teaches or suggests this
21 limitation (Br. 9:Second full ¶).

1 Greene's subscribers enter or program preselected telephone numbers and/or a
2 local exchange into their telephone system (FF 10). Greene does not describe the
3 physical characteristics delineating the telephone system's location, but the act of
4 entering this data into their phone system at least suggests that the data be, if not
5 outright implies that the data is, stored locally, similar to the storage of speed dial
6 numbers in handset databases. Thus, we find the Appellant's arguments
7 unpersuasive.

8 *Dependent Claim 12*

9 The Appellant separately argues the patentability of claim 12. Claim 12 adds
10 the limitation that a user associated with the terminal is permitted to waive the
11 access cost for the given incoming call [from intermediate claim 11] wherein the
12 waiver of the access cost is in response to an offer from the call originator made
13 after the incoming call is routed to and accepted at the user terminal.

14 Appellant's argument is that Greene does not teach or suggest that the "waiver
15 of the access cost is a result of an offer and acceptance in the manner claimed "
16 (Br. 9:Last full ¶).

17 In response to the Appellant's argument, the Examiner asserts that Greene
18 teaches that the subscriber has an option to void or waive the surcharge, and if the
19 subscriber is sympathetic to a particular charity or solicitation, he or she may void
20 the surcharge at any time during the conversation by causing the call to bypass the
21 billing and crediting functions (Answer 10-11). This is consistent with our
22 findings (FF 11).

23 This portion of Greene clearly recites that the waiver may be made in response
24 to a solicitation, which may be characterized as an offer. Therefore, we find the
25 Appellant's arguments unpersuasive.

1 The Appellant has not separately argued claims 2-5, 8, 10, 11, and 15-19, and
2 thus they fall with claim 16.

3 Accordingly we sustain the Examiner's rejection of claims 2-5, 8-12, and 15-19
4 rejected under 35 U.S.C. § 103(a) as obvious over Greene, Lynch-Aird, and
5 Chang.

6
7 *Claim 6 rejected under 35 U.S.C. § 103(a) as obvious over Greene, Lynch-Aird,*
8 *Chang, and Harrison.*

9 The Appellant contends that claim 6 is patentable for the same reasons as claim
10 16 (Br. 10:Top of page), and therefore claim 6 stands or falls with claim 16. We
11 found the Appellant's arguments, *supra*, regarding claim 16 unpersuasive.

12 Accordingly we sustain the Examiner's rejection of claim 6 under 35 U.S.C.
13 § 103(a) as obvious over Greene, Lynch-Aird, Chang, and Harrison.

14
15 *Claims 13 and 14 rejected under 35 U.S.C. § 103(a) as obvious over Greene,*
16 *Lynch-Aird, Chang, Harrison, and Haralambopoulos.*

17 Claim 13 adds the limitation that the set of user-specified access cost
18 information comprises one or more access rules specified by the user and
19 indicating a particular access cost for an incoming call under one or more specified
20 conditions, and at least one of the one or more access rules is associated with an
21 identifier of a particular call originator.

22 The Examiner found that Haralambopoulos discloses that the service provider
23 (called party) has a plurality of individual value-added telephone numbers with
24 each representing a different billing rate to reflect the services rendered, and

1 further disclose that in addition to time related billing rates, the service provider
2 (called party) may have numbers which enable a single item charge. The Examiner
3 concluded that it would have been obvious to one of ordinary skill to modify the
4 system of Greene with the teachings of Haralambopoulos in order to store the
5 caller-specified costs and rules in a database associated with the user terminal to
6 provide the user the convenience to modify or change charges and rules (Answer 7:
7 ¶ referring to claim 13 and 14).

8 The Appellant contends that Haralambopoulos describes a system which
9 depends on an action by the called party. Claim 13, on the other hand, describes a
10 system in which any access costs incurred by the caller are dependent on one or
11 more specified conditions associated with an incoming call. The Appellant
12 contends that these conditions are intrinsic to the incoming call and no actions by
13 the caller during a conversation are required to establish a billing rate. (Br. 10:Last
14 full ¶ - 10:Top of page).

15 Thus, the issue under contention is whether claim 13 requires that no action by
16 the caller is required to establish a billing rate. Claim 13 contains the transition
17 phrase “comprises,” which is open ended in that additional elements might be
18 included within an embodiment and still be within the scope of the claim. Thus, so
19 long as the applied art shows one or more access rules specified by the user and
20 indicating a particular access cost for an incoming call under one or more specified
21 conditions, as Greene does (FF 08-10), then there is no requirement that no action
22 by the caller is required to establish a billing rate. Thus, we find the Appellant’s
23 arguments unpersuasive.

24 As to the Appellant’s argument that the combination would change the
25 principle of operation (Br. 11, First full ¶), citing *In re Ratti*, 270 F.2d 810, 123

1 USPQ 349 (CCPA 1959), while *Ratti* held that a combination of references that
2 would require a substantial reconstruction and redesign of the elements shown the
3 prior art as well as a change in the basic principles under which the prior art was
4 designed to operate is not a proper ground for an obviousness rejection, 270 F.2d at
5 813, 123 USPQ at 352, what *Ratti* was referring to was reconstruction and redesign
6 of how all the elements interrelate in a manner relying on operational principles
7 unforeseeable to a person of ordinary skill.

8 In *Ratti*, claims were directed to an oil seal comprising a bore engaging portion
9 with outwardly biased resilient spring fingers inserted in a resilient sealing
10 member. The primary reference relied upon in a rejection based on a combination
11 of references disclosed an oil seal wherein the bore engaging portion was
12 reinforced by a cylindrical sheet metal casing. Its seal was incompressible and the
13 device required rigidity for operation, whereas the claimed invention required
14 resiliency.

15 But Haralambopoulos' user actions (FF 16), coupled with Greene's automated
16 billing rates (FF 08), would not do such violence to the operating principles of
17 Greene. Modifications by substitution, even if they omit the subject matter portion
18 which a prior art patentee apparently regarded as his contribution to the art along
19 with such advantages as it might provide, where the modified apparatus is obvious
20 in view of the prior art and where the retained portion of the subject matter will
21 operate on the same principles as before, "are not authority for holding a rejection
22 improper under such circumstances." *In re Umbarger*, 407 F.2d 425, 430-31, 160
23 USPQ 734, 738 (CCPA 1959), distinguishing *Ratti*. In this case, modifying
24 Greene by applying Haralambopoulos' user actions still operates on the principles

1 of both Greene and Haralambopoulos, and the combination produces billing rates,
2 as needed in Jones, Among, and the claimed invention.

3 Therefore, we find the Appellant's arguments unpersuasive.

4 The Appellant contends that claim 14 is patentable for the same reasons as
5 claim 13 (Br. 11, Last full ¶), and stands or falls with claim 13.

6 Accordingly we sustain the Examiner's rejection of claims 13 and 14 under
7 35 U.S.C. § 103(a) as obvious over Greene, Lynch-Aird, Chang, Harrison, and
8 Haralambopoulos.

9 CONCLUSIONS OF LAW

10 The Appellant has not sustained its burden of showing that the Examiner erred
11 in rejecting claims 2-6 and 8-19 under 35 U.S.C. § 103(a) as unpatentable over the
12 prior art.

13 On this record, the Appellant is not entitled to a patent containing claims 2-6
14 and 8-19.

15 DECISION

16 To summarize, our decision is as follows:

- 17 • The rejection of claims 2-5, 8-12, and 15-19 under 35 U.S.C. § 103(a) as
18 obvious over Greene, Lynch-Aird, and Chang is sustained.
- 19 • The rejection of claim 6 under 35 U.S.C. § 103(a) as obvious over Greene,
20 Lynch-Aird, Chang, and Harrison is sustained.
- 21 • The rejection of claims 13 and 14 under 35 U.S.C. § 103(a) as obvious over
22 Greene, Lynch-Aird, Chang, Harrison, and Haralambopoulos is sustained.

